

REMARKS

This amendment is filed in response to the Final Office Action issued October 2, 2007, a response to which was due to be filed by January 2, 2008. The Applicant hereby requests a one month extension of time for submitting the present response to the Examiner's report. The requisite fee of \$120.00 under 37 C.F.R. §1.17 (a)(1) is being submitted herewith. The Commissioner is hereby authorized to deduct any necessary fees from our deposit account number 12-2400 in this and future replies.

Claims 1-24 are pending in the present application.

The Examiner has rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over Ould-Brahim et al., "BGP/GMPLS Optical VPNs" (hereinafter "Ould-Brahim") in view of Rosen et al., "BGP/MPLS VPNs" (hereinafter "Rosen").

The Office Action was issued following the United States Supreme Court's decision in the case of KSR Int'l Co. v. Teleflex Inc., No. 04-1350 (April 30, 2007). In light of the KSR decision, Applicant wishes to address various issues pertaining to a proper analysis under section 103.

The Examiner, by citing two references and asserting a reason for combining elements from the two references, has elected to base the rejection of claims 1-23 upon a teaching, suggestion or motivation to select and combine features

from the cited references. Applicant wishes to point out that the Supreme Court's KSR decision did not reject use of a "teaching, suggestion or motivation" analysis as part of an obviousness analysis, characterizing the analysis as "a helpful insight." KSR slip op. at 14-15.

When the Examiner chooses to base a rejection upon a teaching, suggestion or motivation analysis, the Examiner must satisfy the requirements of such an analysis. In particular, the Examiner must demonstrate with evidence and reasoned argument that there was a teaching, suggestion or motivation to select and combine features from the cited references, e.g., In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Moreover, the prior art must suggest the desirability of the combination, not merely the feasibility, see In re Fulton, 73 USPQ2d 1141, 1145 (Fed. Cir. 2004).

In the event that the cited references fail to disclose or suggest all of the elements recited in the claims, then combining elements from the references would not yield the claimed subject matter, regardless of the extent of any teaching, suggestion or motivation.

Although the Supreme Court did not reject use of a "teaching, suggestion or motivation" analysis, the Supreme Court did say that it was not the only possible analysis of an obviousness question. Because of the Examiner's chosen ground for rejection, however, the only pending ground for rejection must be a "teaching, suggestion or motivation" analysis. In the event that the Examiner chooses to consider

a different avenue for rejection, this would be a new ground for rejection not due to any action by Applicant. Applicant has a right to be heard on any new ground for rejection.

Applicant further respectfully reminds the Examiner that, even after KSR, the following legal principles are still valid, having been endorsed by the Supreme Court or having been unaffected by its decision: (1) the USPTO still has the burden of proof on the issue of obviousness; (2) the USPTO must base its decision upon evidence, and it must support its decision with articulated reasoning (slip op. at 14); (3) merely demonstrating that all elements of the claimed invention exist in the prior art is not sufficient to support a determination of obviousness (slip op. at 14-15); (4) hindsight has no place in an obviousness analysis (slip op. at 17); and (5) Applicant is entitled to a careful, thorough, professional examination of the claims (slip op. at 7, 23, in which the Supreme Court remarked that a poor examination reflected poorly upon the USPTO).

Claim 1 requires that a "second subset of elements" implement "a Layer-3 VPN service".

The Examiner has indicated considering that the disclosure of the use of the known Border Gateway Protocol (BGP) between provider edge devices (PEs) in Ould-Brahim is sufficient to qualify as the disclosure of the implementation of "a Layer-3 VPN service" as required by claim 1. The applicant respectfully disagrees.

While the use of BGP by PEs in a network illustrates use of Layer-3

control plane mechanisms, it is submitted that it would be clear to a person of ordinary skill in the art that implementation of a Layer-3 VPN service requires use of Layer-3 control plane mechanisms *in addition to* Layer-3 *data plane* mechanisms. It is further submitted that the data plane of the service provider network in Ould-Brahim, by virtue of being optical, is a Layer-1 data plane. Accordingly, it is submitted that Ould-Brahim does not disclose a subset of elements implementing a Layer-3 VPN service, as required by claim 1.

Since neither Ould-Brahim, nor Rosen, nor a combination of Ould-Brahim and Rosen disclose implementing a Layer-3 VPN service, the combination of Ould-Brahim and Rosen may not be used to reject claim 1 as obvious. It is respectfully requested that the Examiner withdraw the rejection of claim 1, and the rejection of claims 2-11 dependent thereon, on that basis.

Individual elements of claims 12 and 23 require "creating Layer-2 connectivity within said first subset of elements at the Layer-2 level across said Layer-3 VPN service implemented by said second subset of elements via a signalling mechanism". The Examiner has cited a passage from Ould-Brahim wherein Ould-Brahim discloses the use, by a CE, of a (subset of) GMPLS signaling to request the provider network to establish an optical connection to a target port. Leaving aside the question of whether Ould-Brahim has disclosed the creation of Layer-2 connectivity, it is submitted that whatever connectivity that is disclosed as being created is not "across

said Layer-3 VPN service implemented by said second subset of elements", as required by claims 12 and 23, the lack of a Layer-3 VPN service implemented by a second subset of elements having been discussed above in relation to the rejection of claim 1.

Since neither Ould-Brahim, nor Rosen, nor a combination of Ould-Brahim and Rosen disclose creating Layer-2 connectivity across a Layer-3 VPN service, the combination of Ould-Brahim and Rosen may not be used to reject claims 12 and 23 as obvious. It is respectfully requested that the Examiner withdraw the rejection of claim 12 and 23, and the rejection of claims 13-22 dependent on claim 12, on that basis.

The Examiner has rejected claim 24 under 35 U.S.C. § 102(b) as being anticipated by Ould-Brahim.

The Examiner indicates that the PEs in Ould-Brahim are "associated in a Layer-3 Virtual Private Network" as required by claim 24. The Application respectfully disagrees. As discussed hereinbefore, while the use of BGP is known in the control plane of Layer-3 VPNs, the optical service provider network of Ould-Brahim cannot provide the Layer-3 data plane necessary to implement a Layer-3 VPN.

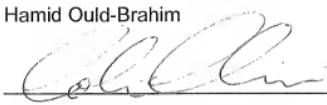
It is submitted that, since Ould-Brahim does not disclose PEs "associated in a Layer-3 Virtual Private Network", Ould-Brahim does not anticipate claim 24. It is respectfully requested that the Examiner withdraw the rejection of claim 24 on that basis.

In view of the foregoing, the applicant respectfully submits that claims 1-24 are in condition for allowance. Favorable reconsideration and allowance of claims 1-24 are respectfully requested.

Respectfully Submitted,

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